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Patrick Engelking

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EXAMINER

NGUYEN, TAN D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/651,878	Applicant(s) ENGELKING ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-25, 27-67 and 83-85 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-21, 23-25, 27-67 and 83-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/09 has been entered.

Response to Amendment

2. The amendment filed 11/13/09 has been entered.

Claim Status

3. Claims 1-9, 10-21, 23-25, 27-67, and 83-85 are pending. Claims 10-14 have been withdrawn. Claims 22, 26, 68, and 86 have been canceled. Current pending claims comprise 6 independent claims sets:

- 1) System¹: 1-9;
- 2) Computer readable storage media (CRSM): 15 -19;
- 3) Method¹: 20-21, 23-25, 27-46,
- 4) CRSM²: 47-61,
- 5) CRSM³: 62-67, 69-82, and
- 6) CRSM⁴: 83-85.

Claims withdrawn: 10-14.

Claims canceled: 22, 26, 68 and 86.

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As of 11/13/09, independent system claim 1 is as followed:

1. (Currently Amended) A system for identifying a business organization transformation opportunity for a business organization that provides a product or service, comprising:

1) a microprocessor configured to receive a plurality of business organization data inputs corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service, analyze at least one of the business organization data inputs by comparing the at least one business organization data input to at least one industry threshold, determine a performance matrix of the business organization based on the comparison, [[and]] model a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service responsive to the analysis, and determine an effect on the performance matrix of transforming the business organization to the second state based on the model; and

2) a hardware display coupled to the microprocessor, the hardware display presenting a user interface that includes information associated with the modeled business organization transformation opportunity scenario.

Note: for convenience, numeral (1)-(2) are added to the beginning of each element.

Principles of Laws

4. 1) In response to applicant's amendment of claim 20, the recitation of "the method comprising a computer:" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

2) Note: independent claim 1 is (appears to be) an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Cir. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

3) Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. “for identifying a business ... or service” carries no patentable weight.

4) Also, the data relating to “a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service” is considered “non-functional descriptive data” (NFDM). When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight.

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That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the “data” relating to “data inputs”, adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed." Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data.

See MPEP 2106.01 “Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

2106.01 Computer-Related Nonstatutory Subject Matter [R-6]

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and

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Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754, 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diamond v. Diehr*, 450 U.S. 175, 185-86, 209 USPQ 1, 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel

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need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

5) a model for a CRSM claim:

A computer-readable storage medium having stored thereon a computer program for "xxxx", the computer program comprising a routine set of instructions which when executed by a computer machine cause the computer machine to perform the steps of: "xxxx".

I. FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES" REPRESENTING DESCRIPTIVE MATERIAL *PER SE* OR COMPUTER PROGRAMS REPRESENTING COMPUTER LISTINGS *PER SE*

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise

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statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. **When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim.** ** When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.

Note that the computer program is claimed in a **in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim.** Otherwise, it's treated as a product claim or software stored on a disk.

Finding of Facts

1) The term “**threshold**” is defined as:

Main Entry: **thresh·old**

Pronunciation: \ˈthresh-,hōld, ˈthre-,shōld\

Function: *noun*

Etymology: Middle English *thresshold*, from Old English *threscwald*; akin to Old Norse *threskjǫldr* threshold, Old English *threscan* to thresh

Date: before 12th century

1 : the plank, stone, or piece of timber that lies under a door : SILL

2 a : GATE, DOOR **b (1)** : END, BOUNDARY; *specifically* : the end of a runway **(2)** : the place or point of entering or beginning : OUTSET <on the threshold of a new age>

3 a : the point at which a physiological or psychological effect begins to be

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produced <has a high threshold for pain> **b** : a level, point, or value above which something is true or will take place and below which it is not or will not

2) The term “**matrix**” is defined as:

Main Entry: **ma·trix**

Pronunciation: \ˈmā-triks\

Function: *noun*

Inflected Form(s): *plural* **ma·tri·ces** \ˈmā-trə-,sēz, ˈma-\ or **ma·trix·es** \ˈmā-trik-səz\

Etymology: Latin, female animal used for breeding, parent plant, from *matr-*, *mater*

Date: 1555

1 : something within or from which something else originates, develops, or takes form

2 a : a mold from which a relief surface (as a piece of type) is made **b** : DIE 3a(1) **c** : an engraved or inscribed die or stamp **d** : an electroformed impression of a phonograph record used for mass-producing duplicates of the original

3 a : the natural material (as soil or rock) in which something (as a fossil or crystal) is embedded **b** : material in which something is enclosed or embedded (as for protection or study)

4 a : the extracellular substance in which tissue cells (as of connective tissue) are embedded **b** : the thickened epithelium at the base of a fingernail or toenail from which new nail substance develops

5 a : a rectangular array of mathematical elements (as the coefficients of simultaneous linear equations) that can be combined to form sums and products with similar arrays having an appropriate number of rows and columns **b** : something resembling a mathematical matrix especially in rectangular arrangement of elements into rows and columns **c** : an array of circuit elements (as diodes and transistors) for performing a specific function

6 : a main clause that contains a subordinate clause

See *Merriam-webster Online Dictionary*, available at <http://www.merriam-webster.com/dictionary/event> (visited on January 30, 2010).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 20-21, 23-25 and 27-46** (method) are rejected under 35 U.S.C. 101.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must:

(1) be tied to a particular machine or apparatus or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

(a) To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

(b) There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable

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process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

(c) Here, applicant's method steps fail the first prong of the new test because the only tie to a computer occurs in the preamble and the preamble normally carries no patentable weight. Furthermore, it's not clear whether all or portion of the steps is/are carried out by the computer cited in the preamble.

(d) Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

7. Claims 1-9 (system) are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

The independent claim 1 begin by discussing a system/apparatus, however the claim contains method step of "the hardware display presenting a user interface" the 2nd element. A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548). Note that the language for indicating an apparatus in claims 1-9 has been "configured to" and so this language should be used in the 2nd element of claim 1.

Claim Rejections - 35 USC § 112

8. Claims 1-9, 15-21, 23-25, 27-67, and 83-85 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In independent claims 1, 15, 20, 47, 62 and 83, the phrase “comparing the at least one business organization data input to at least one industry threshold..”, is vague because it’s not “threshold” (information or data or value) or what features or parameters?

2) In independent claims 1, 15, 20, 47, 62 and 83, it’s not clear how the “2nd state” value is formed? Randomly any number that is “different” from the “1st state”?

3) In independent claims 1, and 20, the last element or step of “presenting a user interface that includes **information** associated with the modeled business organization transformation opportunity **scenario**” is vague because the result of the previous element/step is “**a determined effect** on the performance matrix of transforming the business organization to the 2nd state based on the model” and so, the display should show “**the determined effect**”.

4) In independent claims 15, 47, 62 and 83, they appear to be incomplete because the last step calls for “determine an effect on the performance matrix of transforming the business organization to the second state based on the model” , which appears to be incomplete because all of these steps are internal inside the computer

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and the result should be displayed to a user to see/view and use it to do something else.

5) in dep. claims 9, 19, 46, 82, the phrase “one industry threshold includes information...a number of employees desired for performing the first business organization function” is vague because it’s not clear what this phrase means?

6) Claims 1-9 are vague and indefinite since the dependent claims uses “method steps” such as “presenting”, in an apparatus claims. See *IPXL Holdings, Va. Amazon.com* (Fed. Circuit 2005). System claim that includes a method step is invalid as indefinite.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-9 (system), 15-19 (CRSM), 20-21, 23-25, 27-46 (method), 47-61 (CRSM), 62-67, 69-82 (CRSM), and 83-85 (CRSM) are rejected under 35 U.S.C. 103(a) as obvious over HUANG et al (US 6,151,582).

Similarly, HUANG et al discloses a system, method, and CRSM for identifying a business organization transformation opportunity for a business organization that provides a product or service, comprising:

1) a microprocessor configured to

a) receive a plurality of business organization data inputs corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service,

b) analyze at least one of the business organization data inputs by comparing the at least one business organization data input to at least one industry threshold,

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c) determine a performance system (charts or list) of the business organization based on the comparison,

d) model a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service responsive to the analysis, and

e) determine an effect on the performance system (charts or list) of transforming the business organization to the second state based on the model; and

{see Figs. 7, 41, 42, 63-67, col. 12, lines 35-50, col. 38, lines 55-67, col. 50, lines 1-25, col. 91, lines 35-67, col. 99, lines 10-60, cols. 111-112}

2) a hardware display coupled to the microprocessor, the hardware display presenting a user interface that includes information associated with the modeled business organization transformation opportunity scenario.

{see Figs. 7, 44, 47, 63-67, col. 96, lines 50-67, col. 99, lines 13-37}

HUANG et al fairly teaches the claimed invention except for explicitly using the term a performance “matrix” vs. performance chart or list of features as shown in Figs. 63-64, col. 110, line 60 to col. 111, line 67. Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as “PHOSITA”) at the time of the invention was made to use other similar term for “performance parameters” such as “matrix” as mere using other similar term or features to achieve similar results.

Note that the term “threshold”, which means “a level, point, or value about which something is true or will take place and below which it is not or will not”, or “a point at which a physiological or psychological effect begins to be produced”, or “inflection point”, etc., this is a relative term and the features taught on col. 12, lines 25-50, such as ***“the enterprise should expand, maintain or reduce its production capacity,... impact...”***, reads over this “threshold” definition since a change is taking place to improve a condition. Alternatively, in view of the general teachings above, the use of any other similar term to reflect a change such as “threshold” would have been obvious as mere using other similar term for the same “changing” effect.

Moreover, this appears to be a computer-implemented system or “data processing” and limitation such as “threshold”, “matrix”, etc, they are considered as non-functional descriptive material (NFD) on the data of “...”, thus having no patentable weight. The mere insertion of “threshold” or “client data” data over “data” does not “impart functionality when employed as a computer component”, thus having no patentable weight.

See MPEP 2106.01 “Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive

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material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

As for dep. claims 2-4, 9 (part of 1 above) which deal with types of business functions, scenarios, etc., these are taught in Figs. 1, 2-3, 7-8, 11,15, 37, 49 and cols. 1-2 and 112. As for the use of any other business functions or features, the use/applying of the same analysis and modeling system for any other business functions or features would have been obvious as mere using other similar features to achieve similar results.

As for dep. claims 5-6 (part of 1 above) which deal with types of business data inputs, etc., these are taught in Figs. 1, 2-3, 7-8, 11,15, 37, 49 and cols. 1-2, and 112. As for the use of any other business functions or features, the use/applying of the same analysis and modeling system for any other business functions or features would have been obvious as mere using other similar features to achieve similar results.

As for dep. claims 7-8 (part of 1 above) which deal with types of execution of the microprocessor, these are taught in Figs. 7, 46-49, cols. 102-103.

As for independent CRSM claims 15-19, Method claims 20, 21, 23-25, 27-46, CRSM 47-61, CRSM 62-67, 69-82 and CRSM 83-85, they are basically the CRSM, and method to carry out the system claims 1-9 above, and are rejected over the CRSM and method claims of HUANG et al to carry out the rejections of system claims as shown on Figs. 2-5. In other words, these group of claims have similar scope to the system claims of 1-9, are rejected for similar reasons set forth in the rejections of claims 1-9 for convenience. As for the differences in the types of information, functions, etc., they are

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within the skill of the artisan and would have been obvious to make minor modifications within deviation from the main scope of HUANG et al as taught in [0143].

Note for the CRSM claims 15, 47, 62, and 83, they do not contain the phrase "the computer program comprising a routine set of instructions which when executed by a computer machine cause the computer machine to perform the steps of: "xxxx". So they are merely considered as "a product claim or software stored on a disk" and the CRSM of HUANG et al is capable of having all of the features as claimed.

Response to Arguments

13. Applicant's arguments with respect to claims 1-9 (system), 15-19 (CRSM), 20-21, 23-25, 27-46 (method), 47-61 (CRSM), 62-67, 69-82 (CRSM), and 83-85 (CRSM) on 11/13/09 have been considered but are moot in view of the new ground(s) of rejection which are caused by applicant's amendment of the claims.

No claims are allowed.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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3. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689